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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,411	08/14/2006	Mauro Marinelli	KAR 014	3620
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Themis Intellectual Property Counsel 7660 Fay Ave Ste H378 La Jolla, CA 92037			EXAMINER ROZANSKI, MICHAEL T	
			ART UNIT	PAPER NUMBER
			3768	
			MAIL DATE	DELIVERY MODE
			12/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/538,411

Applicant(s)

MARINELLI, MAURO

Examiner

Michael Rozanski

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 13-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/31/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

In respect to the restriction requirement, Claims 32-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/31/07.

Applicant's election with traverse of Species A (claim 1-2 and 4-12) in the reply filed on 10/31/07 is acknowledged. The traversal is on the ground(s) that claim 1 is a generic claim and there would be no search burden on the Examiner to search unelected Species because they depend from a generic claim. The Examiner acknowledges that claim 1 is a generic claim. However, Applicant's arguments are not found persuasive because Examiner holds that the species embodiments are non-obvious variants and, therefore, would require an additional search. Further, it is the unelected dependent claims that would require a further search *in addition to* a search of the elected Species A. Whether or not these claims depend from a generic claim is irrelevant. Applicant is entitled to consideration of all of the dependent claims once claim 1 is found allowable. However, as claim 1 is rejected for the reasons set forth below, consideration of the non-elected species is not proper at this time. In addition, Examiner notes that claim 3 should be examined because Figure 7 (originally denoted as Species B) should be encompassed into Species A.

The requirement is still deemed proper and is therefore made FINAL. Claims 13-31 are withdrawn.

### ***Drawings***

The drawings are objected to because there are handwritten element numerals and labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: Dependency is not set forth. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claims 1 and 6-7*** are rejected under 35 U.S.C. 102(e) as being anticipated by ***Avrin et al*** (US PUB 2002/0151779 –cited by Applicant).

Avrin et al disclose a susceptometer for measurement of iron concentrations (para [0006]) including a heat insulating case 26 with a source-sensor unit 20 for providing support, which is made of non-magnetic and electrically insulating material, and operationally kept at room temperature (para [0029]). The device also includes an alternating magnetic field source 12 supported by the structure and at least two magnetic field sensors 14 supported by the structure and disposed symmetrically with respect to the field source 12 (para [0027]). A water bag 40 provides means for introducing the body to be screened in the screening region defined by the field source and sensors (para [0049]). The bag supplies an interface and, thus, is used to introduce to body into a region of the magnetic field. The temperature inside the case

has limited variation such that the thermal expansion and contraction will be the same for elements on one side of mirror symmetry as the other side, so that the cancellation of the applied field at the magnetic sensors is preserved (para [0031]). Heat can be removed from the unit by providing a thermal link to the outside world to provide a point at which the temperature can be controlled, by using active feedback, or by putting the unit in thermal contact with an appropriate temperature-stabilizing system (para [0039-0040]). Furthermore, Avrin et al disclose means for processing AC or DC magnetic susceptibility measurements (para [0045, 0050]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 2-5, and 8-12*** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Avrin et al*** as applied to claim 1 in view of ***Steketee et al*** ("Measurement of magnetic susceptibility in living rats").

Avrin et al substantially disclose all features of the current invention but do not disclose a screening region tunnels between the source and sensor, a second insulating case, a lock-in amplifier, or temperature-controlled fluid flow. However, Steketee et al teach of magnetic susceptibility including two further heat shields that are placed in the tunnel. Each shield is formed by two glass plates forming a liquid-tight channel through

which water from a thermostat could be passed (see Figures 2a, 2b). Figure 3 shows a lock-in amplifier that reads the signal produced by sensors. The arrangement of Steketee et al also shows secondary coils (see Figure 4). It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Avrin et al, as taught by Steketee et al, because using tunnels would provide means for introducing the body into the screening region without usage of a water bag, as described in Avrin et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR  
MR

  
ERIC F. WINAKUR  
PRIMARY EXAMINER